

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte YASUHIRO HARITA  
and  
TOSHIHIRO SATO

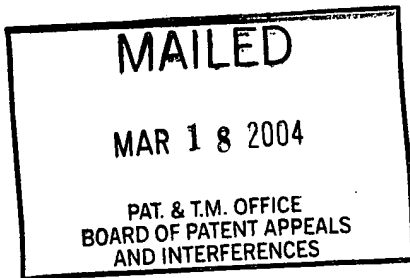
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Application No. 09/788,428

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ORDER RETURNING TO EXAMINER

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This application was received at the Board of Patent Appeals and Interferences on March 8, 2004. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith returned to the examiner. The matters requiring attention prior to docketing are identified below.

An examination of the record indicates that in the Final Rejection mailed November 4, 2002 (Paper No. 7), the following rejections were made:

1. Claims 1, 4, 5, 9, 14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Strobl (U.S. Patent no. 5,360,274);

2. Claims 1, 4-6, 9, 14, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Winkelmann (U.S. Patent no. 3,770,990); and

3. Claims 2, 3, 7, 8 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strobl in view of Rose (U.S. Patent no. 3,239,287).

However, in the Examiner's Answer mailed August 11, 2003 (Paper No. 14), the examiner only lists the following rejection:

1. Claims 2-5, 7, 8, and 11-15 are rejected under 35 U.S.C. 103.

It should be noted that there is also no indication in the record regarding the status of the § 102 rejections. In addition, it appears that because of the inclusion of claims 4, 5, 11 and 15 to the § 103(a) rejection as being unpatentable over Strobl in view of Rose (U.S. Patent No. 3,239,287), this is a new ground of rejection.

On December 1, 1997, the rule pertaining to the Examiner's Answer and Reply Brief (37 CFR § 1.193) was amended to read as follows:

(a)(2) An examiner's answer must not include a new ground of rejection . . . .

Finally, Section 1208 of the Manual of Patent Examining Procedure (MPEP) (8th Ed., Rev. 1, Feb. 2003) states:

On the examiner's answer, below the primary examiner's signature, the word "Conferees:" should be included, followed by the typed or printed names of the other two appeal conference participants. These two appeal conference participants must place their initials next to their name. This will make the record clear that an appeal conference has been held. [Emphasis added.]

The Examiner's Answer mailed August 11, 2003 (Paper No. 14) does not comply with the above requirement.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

1. for clarification regarding the status of the § 102(b) rejections listed in the Final Rejection mailed November 4, 2002 (Paper No. 7);
2. for a determination regarding the status of the rejection of claims 2-5, 7, 8, and 11-15 under 35 U.S.C. § 103(a). If this rejection is to remain, the rejection is considered to be a new ground of rejection and the entry of the Examiner's Answer mailed August 11, 2003 (Paper No. 14) is inappropriate. Accordingly, the Examiner's Answer needs to be

Application 09/788,428

vacated and prosecution reopened. If the rejection is to be withdrawn, the Examiner's Answer will need to be vacated and a Supplemental Examiner's Action issued in its place.


3. for taking corrective action regarding the appeals conference;

4. for written notification to appellants regarding the action taken; and

5. for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

By:

  
DALE SHAW  
Program and Resource Administrator  
(703) 308-9797

cc: Posz & Bethards, PLC  
11250 Roger Bacon Drive  
Suite 10  
Reston, VA 20190

DS/psb/dm  
ra040338